

## **STATUS OF CLAIMS**

Claims 1-30 are pending.

Claims 1-30 stand rejected by the Examiner.

## **REMARKS**

Reconsideration of the present Application is respectfully requested.

### **Rejections based on 35 U.S.C. § 103 (a)**

Claims 1-3, 6, 9-10, 15-16, 19, 22-23 and 25-26 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen (U.S. Patent No. 6,628,939) in view of Tendler (U.S. Patent No. 6,778,820) and further in view of Paravia et al. (U.S. Patent No. 6,508,710). Claims 27-30 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen and Tendler, in further view of Walker et al. (U.S. Patent No. 6,527,638). Claims 4-5, 7-8, 17-18 and 20-21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen, Tendler, and Paravia in further view of Clapper (U.S. Patent Application Publication No. 2002/0168967). Claims 11, 13 and 24 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen, Tendler, and Paravia in further view of Kotzin et al. (U.S. Patent No. 6,470,180). Claim 12 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Paulsen, Tendler, Paravia, and Kotzin, in further view of Thiriet (U.S. Patent No. 6,650,892). Claim 14 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Kotzin and Tendler, in further view of Paravia. Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits the cited references fail to teach or suggest at least each of the limitations of independent Claims 1, 14 and 15, either alone or in combination. Claim 1 reads as follows:

An electronic gaming system for enabling one or more player devices disposed at locations remote from a gaming source, the devices receiving communications from the gaming source, the gaming system comprising:  
an RF sub-carrier broadcast station, the station communicating game play signals developed by the gaming source;

at least one player device disposed at a first location, the player device including electronic game play means for enabling a player to make a wager by inputting wager data, and to commence game play by causing an activation signal to be received and processed;  
and

wherein the player device is placed in condition to receive said activation signal by the device's first location being within a bounded authorized area.

Applicant respectfully submits that none of the cited references, either separately or in combination, teach or suggest commencing game play by causing **an activation signal** to be received and processed, as recited in Claim 1. Applicant agrees with the Examiner that “Paulsen fails to disclose the player device is placed in condition to receive said activation signal by the device’s first location being within a bounded authorized area.” Applicant also agrees with the Examiner that the combination of Paulsen and Tendler does not teach “commence game play by causing an activation signal to be received and processed.”

Rather, the Examiner cites to column 20, lines 9-22 of Paravia for support for this teaching admittedly not present in Paulsen and Tendler. However, Applicant respectfully submits that the present Office Action mischaracterizes the cited portion of Paravia. This cited paragraph of Paravia discusses an automatic call-back procedure whereby a direct communication link is established between the gaming server and the player’s computer or terminal. *See* col. 20, lines 14-16. The purpose of this call-back wagering process is to perform “location verification” and to register “the player’s gaming selection with the gaming server,” not to activate the gaming device. *See* col. 21, lines 9-12. After the gaming server confirms the location and identity of the player, “then the gaming server *obtains* the player gaming selections.” Col. 21, lines 60-61. This may occur *automatically* or it may occur manually *after input from the player*. Col. 21, lines 61-64. There is no suggestion or teaching that the player device receives an activation signal, or that the device of Paravia can even be deactivated or is activated. As stated in Paravia, retrieval of the gaming selection may occur automatically or after input from the player. If it occurs automatically, it is clear that no activation is required. Moreover, a player in Paravia could not activate the device, because allowing a player to activate the device in Paravia would contravene one of the central purposes of Applicant’s invention: to ensure that the device is located within an authorized area before game play can begin. *See* paragraph 68, stating “once a remote gaming device has been

activated, its location verified and a valid PIN number confirmed, the device may now be utilized to access and bet on real-time gaming.” Therefore, the cited portion of Paravia fails to disclose an activation signal being received and processed by the player device for activation of the device.

The Examiner also cited to column 19, line 63 through column 20 line 2 of Paravia. This also fails to address activation of the player device to receive game play data. The cited portion merely states that the “the player’s gaming selections are entered in the gaming server.” There is no mention or teaching of activation of the player device.

Regarding Claims 14 and 15, for the same reasons as discussed above, the cited references do not teach or suggest activation of the gaming device. In discussing claim 15, the Examiner has cited to the language of original claim 15 and not that of amended claim 15. Claim 15 requires that the device be *activated* to receive game play data. Claim 14 also requires that the gaming device be activated for game play. Therefore, the same arguments raised above with respect to claim 1 also apply to claims 14 and 15.

Applicant further submits that Claims 2-13 and 16-30 are similarly distinguishable over the prior art of record, at least by virtue of their ultimate dependency from a patentably distinct base claim.

Applicant also respectfully submits there is no reason to combine the teachings of the cited references. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art and not based on an applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). More specifically, MPEP 2144.08 (II)(A) states:

To establish a prima facie case of obviousness in a genus-species chemical composition situation, as in any other 35 U.S.C. 103 case, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings. See, e.g., In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) (“[T]he mere possibility

that one of the esters or the active methylene group-containing compounds... could be modified or replaced such that its use would lead to the specific sulfoalkylated resin recited in claim 8 does not make the process recited in claim 8 obvious 'unless the prior art suggested the desirability of [such a] modification' or replacement.") (quoting *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) ("[A] proper analysis under 103 requires, inter alia, consideration of . . . whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process."). In order to find such motivation or suggestion there should be a reasonable likelihood that the claimed invention would have the properties disclosed by the prior art teachings. . . . See, e.g., *Vaeck*, 947 F.2d at 493, 20 USPQ2d at 1442 (A proper obviousness analysis requires consideration of "whether the prior art would also have revealed that in so making or carrying out [the claimed invention], those of ordinary skill would have a reasonable expectation of success.")

As set forth hereinabove, an office action must set forth *some motivation or suggestion to make the claimed invention in light of the prior art teachings*. See, e.g., *In re Brouwer*. As explained above, none of the cited references teach the activation of the gaming device. Assuming *arguendo* that Paravia does teach this claim element, there is no motivation or suggestion to combine it with either Paulsen, Tendler or Kotzin. As the Examiner noted, "Paulsen fails to disclose the player device is placed in condition to receive said activation signal by the device's first location being within a bounded authorized area." Thus, activation of the device would not be necessary in Paulsen since the location of the device is unimportant.

Further, Tendler teaches a different mechanism of ensuring that the device is located within an authorized area. According to Tendler, in order to keep an individual from spoofing the system, "the latitude and longitude must be ascertained as being within the prescribed boundary. The time since last fix must be less than pre-determined time limit, the mobile identification number must be that which is [sic] already been authorized, and the new location must not be the same as the previous stored location." See column 4, lines 28-34. Therefore, activation of the device would be an entirely redundant safeguard against illegal use.

Finally, there is no motivation to combine Paravia with Kotzin. Kotzin is not concerned with the location of the handheld wireless device, therefore, there would be no need or desire to activate the device. Such a safeguard is unnecessary. Applicant respectfully submits that the cited references do not teach or suggest all of the claim limitations and further that there is no teaching or motivation to combine these references.

### **CONCLUSION**

Wherefore, Applicant believes that all outstanding grounds raised by the Examiner have been addressed and respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or outstanding matters, the Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

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Respectfully submitted,



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